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Attorney Docket 088305-0121

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Paul Levi WILLIAMS, Jr., et al.
Title: PROVISION OF ELECTRONIC COMMERCE SERVICES
Appl. No.: 09/741,994
Filing Date: 12/22/2000
Examiner: M. A. Cuff
Art Unit: 3627

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
AND RESUBMISSION OF REVISED APPEAL BRIEF**

Mail Stop APPEAL BRIEFS - PATENTS

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Response is responsive to the Notification of Non-Compliant Appeal Brief dated October 18, 2005, concerning the above-identified application. The Response is being timely filed and no fee is believed to be due.

With respect to paragraph (8) in the Notification, please note that no evidence was submitted or relied-upon under 37 C.F.R. § 1.130, 1.131, or 1.132 as would be apparent from even a cursory review of the file. Section 41-37(c)(ix) requires copies of any evidence submitted. Since no evidence was submitted this appendix is not required.

With respect to paragraph (9) in the Notification, there are no decisions on any proceeding by a court or board as clearly stated in paragraph (2) of the Appeal Brief. 37 C.F.R. § 41.37(i)(x) requires copies of decision rendered but since there are no such decision (as clearly stated in paragraph (2) of the Appeal Brief), nothing is required in this case under 37 C.F.R. 41.37(c)(x).

Accordingly, applicants believe that the Appeal Brief, submitted on August 2, 2005, was fully compliant with the requirements of 37 C.F.R. § 41.37. Accordingly, this Notification of Non-Compliant Appeal Brief is believed to be erroneous and should be withdrawn.

However, to expedite prosecution, Applicants are resubmitting the Appeal Brief with an Evidence Appendix under 37 C.F.R. 41.37(c)(1)(ix) indicating "None" and a Related Proceedings Appendix Under 37 C.F.R. § 41.37(c)(1)(x) indicating "None".

If the examiner believes otherwise, the examiner is encouraged to contact the undersigned attorney at the local telephone number below.

In view of above, appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejection of the pending claims and pass this application on to allowance.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

Date November 17, 2005

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The following is the Appellant Appeal Brief under the provisions of 37 C.F.R. 41.37.

1. Real Party in Interest

The real party in interest is Global eXchange Services, Inc. (with a principle place of business in Gaithersburg, Maryland), which is the successor in interest in this patent application to the assignee of record, G.E. Information Services, Inc., a corporation under the laws of the State of Delaware.

2. Evidence Appendix

There are no related evidence that will directly affect, be directly affected by or have a bearing on the present appeal, that are known to appellant, the assignee, or the appellant's patent representative. The Evidence Appendix (Section 10), attached hereto, states "None".

3. Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly affected by or have a bearing on the present appeal, that are known to appellant, the assignee, or the appellant's patent representative. The Related Proceedings Appendix (Section 11), attached hereto, states "None".

4. Status of Claims

The present appeal is directed to claims 1-28 which are the claims under consideration. A copy of the pending claims 1-28 are attached herein in the Claims Appendix (Section 12).

Claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 are finally rejected under 35 U.S.C. § 102(a) as being anticipated by www.ediconsulting.com (document from website dated October 14, 1999; hereafter "EdisonConsulting"). Claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.ediconsulting.com, in view of U.S. patent no. 5,913,210 ("Call"), U.S. patent no. 5,862,325 ("Reed"), and U.S. patent no. 6,408,292 ("Bakalash").

5. Status of Amendments

Claims 1-28 were initially pending in the application filed on December 22, 2000. Claims 1, 2, 12, 19, 20, 27, and 28 were amended in an Amendment and Reply Under 37 C.F.R. § 1.111 filed December 15, 2003 in reply to a first Office Action on the merits mailed on September 16, 2003.

Claims 1, 19, 27, and 28 were amended in an Amendment and Reply Under 37 C.F.R. § 1.116 filed May 3, 2004 in reply to a final Office Action mailed on February 5, 2004, which rejected all claims. A Notice of Appeal was filed on July 2, 2004. An Advisory Action was mailed on August 5, 2004, which stated that the new independent claim limitations require further consideration and/or search after consideration of the Amendment.

A Request for Continued Examination (RCE) was filed on August 16, 2004 requesting entry of the Amendment filed on May 3, 2004.

Claims 1, 19, 27, and 28 were amended in an Amendment and Reply Under 37 C.F.R. § 1.111 filed December 29, 2004 in reply to a non-final Office Action mailed on September 29, 2004.

Claims 1-28 are rejected in final Office Action mailed March 4, 2005. A Notice of Appeal was filed on June 2, 2005.

6. Summary of the Invention

Independent claims 1, 19, 27, and 28 are directed to a method, system, and computer program product for providing electronic commerce electronic data interchange (EDI) products and services for EDI between a user and one or more trading partners.

Figure 1 illustrates the connection between trading partners 100 and a hub 102 for exchanging business transactions (related to electronic commerce/electronic data interchange or EC/EDI). As described in the specification, the host server “automates the business processes between two or more trading partners and the host organization for the host server. For example, the host server recognizes a trading partner, presents as options only those products and services which are acceptable to a trading partner....[so that] the user is able to complete an order or registration for these products or services.” See page 6, lines 20-27 of the specification. The EC/EDI products are determined based on the requirements of those trading partners. See page 5, lines 26-27 and page 10, lines 8-26.

As described in figure 4, the user is provided a funnel process by which information is obtained from the user to identify a plurality of trading partners. See page 9, lines 3-16 of the specification. For example, once the user selects an existing hub (that the user wishes to trade with as a trading partner), information regarding the details of the EDI facilities available on the selected hub are automatically presented to the user. This information may include, for example, the identity and description of the software packages necessary to support different types of commercial transactions with the hub or particular configurations of the software specifically applicable to the selected hub. See page 11, lines 21-26 or page 16, lines 25-30 of the specification.

Once a user has selected all of the relevant hubs, the host server recommends appropriate software, services, and associated products for the user’s desired EDI process.

See page 19, lines 9-11. Thereafter, registration information is obtained from the user to register the user for one or more of the appropriate software, services, or associated products. See, for example, page 19, lines 12-16.

With respect to the means-plus-function limitations recited in claim 27, these means correspond to the host server described, for example, in page 6, lines 8-28 and which is programmed with the logic disclosed with respect to flow chart of figure 4.

7. Issues

The issue on appeal is whether the examiner erred in rejecting claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 under 35 U.S.C. § 102(a) as being anticipated by EdisonConsulting and in rejecting claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over EdisonConsulting in view of Call, Reed, and Bakalash.

8. Argument

It is respectfully submitted that the final rejection of claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 under 35 U.S.C. § 102(a) as being anticipated EdisonConsulting is erroneous for at least the following reasons.

Each of the independent claims 1, 19, 27, and 28 recite a method (or system/software) for automatically determining EDI products and services to allow a user (of a host server) to efficiently perform EDI with a plurality of trading partners. Therefore, these claims recite, *inter alia*, an automated method (and corresponding software application and database) that allows automatic determination, by the host server (or an application therein), of suitable EDI products or services for performing EDI with each of a plurality of selected trading partners. These recited features are not disclosed or suggested by the applied prior art.

Specifically, nowhere does EdisonConsulting disclose or suggest this automated determination by a host server of the suitable EDI products and services that are needed to perform EDI with a plurality of selected trading partners. The cited web pages disclose performing EDI *evaluations*, mapping *support*, ongoing *support* for outsourced EDI, and *Systems Integration* all of which are well known in the art as being descriptive of manual custom integration, support, and testing for clients. Therefore, nowhere does EdisonConsulting teach a host server (or application therein) that automatically determines

suitable EDI products or services for a user based in the requirements information from the trading partners selected by the user.

Furthermore, to the extent that the EdisonConsulting references is relevant to the claimed invention, it teaches away from the claimed invention recited in the pending claims since the process taught by EdisonConsulting requires the use of their experts with specialized knowledge and all the attendant disadvantages related to hiring and depending on such experts.

With respect to the claimed automatic determination by the host server (or application therein) of the suitable EDI products or services for one user to transact with a plurality of trading partners, the final office action asserts “[t]he prior art has automatically determined that the mapping services are suitable for a user, particularly to help interface with the requirements of the other trading partners.” See page 5 of final office action dated March 4, 2005. However, this refers to manual mapping support for manually building maps between the EDI transactions of a user with its trading partner, for example, to map the specific transactions between a user and a specific trading partner. Nowhere does this teach the claimed host server (or application therein) automatically determining the specific EDI products or services for a plurality of trading partners selected by the user.

In order for a reference to be utilized as an anticipatory reference under the provisions of 35 U.S.C. § 102, the reference must disclose each and every claim limitation. This is certainly not the case here, and thus the Sec. 102 rejection as to the independent claims 1, 19, 27, and 28 is erroneous and should be reversed.

With respect to the anticipation rejection, the office action acknowledges that Edisonconsulting.com is “silent on a database of information on a plurality of hub trading partners,” and relies on inherency for this recited feature. It should be noted that “[t]he fact that certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result of characteristic.” See *In re Rijcskaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (also cited in MPEP § 2112). Furthermore, as noted in MPEP § 2112, “Inherency, however, may not be established by probabilities or possibilities.” (Emphasis added). With respect to this feature, the final office action (dated March 4, 2005) again asserts that “it would be fair to say the reference saved some of its past work facilitate (sic)

future job...” That is, the examiner is again relying on *probability or possibility* that such a database existed and the specific recited information was stored therein and of course that the database was used as recited in the claims. The examiner fails to meet the burden of proving inherency contrary to the assertion in the final office action. Therefore, when a recited feature in the independent claims is not disclosed in the applied prior art, anticipation is improper and this rejection of the independent claims should be withdrawn.

Furthermore, as discussed above, the independent claims recite an automated method (and system/software) that automatically selects (at a host server) the suitable EDI products and services for each of a potentially a vast number of selected EDI trading partners so that EDI with each of the selected EDI trading partners (with their own requirements and products) can be efficiently performed. One of the advantages of the claimed method and system is that it eliminates or reduces the need for the custom system integration and mapping services by an “expert” as offered the EdisonConsulting reference. Therefore, not only does EdisonConsulting not disclose the features recited in the pending claims, it actually teaches away from the claimed invention by requiring custom solutions and expertise in sharp contrast to the claimed automated determination recited in the pending claims.

Furthermore, the deficiencies of EdisonConsulting are not cured by any of the other applied references. Therefore, neither the specific recited features nor their advantages are disclosed or suggested by the applied prior art. Accordingly, the pending independent claims are patentable over the applied prior art.

The dependent claims are also patentable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

9. Conclusion

In view of above, appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejection of the pending claims and pass this application on to allowance.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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10. **EVIDENCE APPENDIX**

None

11. RELATED PROCEEDINGS APPENDIX

None

4/21

12. CLAIMS APPENDIX

LIST OF THE PENDING CLAIMS (WITH STATUS IDENTIFIER)

1. (Previously Presented) A method for providing electronic commerce electronic data interchange (EDI) products and services for EDI between a user and one or more trading partners, the method comprising the steps of:
 - providing a host server for access by said user;
 - obtaining first information from said user to identify a plurality of selected trading partners for exchanging EDI information related to trading with the selected trading partners;
 - retrieving requirements information relating to predetermined electronic commerce EDI requirements of said selected trading partners;
 - automatically determining, by the host server, suitable electronic commerce EDI products or services for said user based at least in part on said requirements information from said selected trading partners; and
 - obtaining registration information from said user to register said user for one or more of said suitable EDI products or services.
2. (Previously Presented) A method as claimed in claim 1, wherein said server retrieves said requirements information from a database containing electronic commerce EDI requirements information for a plurality of hub trading partners.
3. (Original) A method as claimed in claim 1, wherein said step of obtaining registration information comprises prompting said user to enter information into one or more preformatted displays.
4. (Original) A method as claimed in claim 3, further comprising the steps of:
 - dividing said registration information into common registration information and other registration information; and
 - storing said common registration information so that it is readily accessible in a block.

5. (Original) A method as claimed in claim 4, wherein registration information, entered by said user into predetermined areas of said one or more preformatted displays, is designated as common registration information.

6. (Original) A method as claimed in claim 4, wherein said step of obtaining registration information comprises prepopulating one or more of said preformatted displays with common registration information previously entered by said user.

7. (Original) A method as claimed in claim 6, wherein said step of obtaining registration information comprises a plurality of sessions, information entered during a first session being stored and retrieved during a second session.

8. (Original) A method as claimed in claim 7, wherein first date information is stored indicating a date when said first session information is entered, said first date information is compared to current date information to determine if said information entered during said first session can be used for said second session.

9. (Original) A method as claimed in claim 8, wherein said first date information is determined from a cookie sent to a user's browser.

10. (Original) A method as claimed in claim 1, further comprising the step of prompting said user for configuration information to configure one or more of said products or services.

11. (Original) A method as claimed in claim 1, further comprising the step of automatically generating and sending a message to a sales channel to follow up in providing electronic commerce products or services desired by said user.

12. (Previously Presented) A method as claimed in claim 1, further comprising the step of generating return-on-investment information relating to an e-commerce product or service and providing said return-on-investment information to said user.

13. (Original) A method as claimed in claim 1, further comprising the step of accepting an order for one or more of said products or services from said user.

14. (Original) A method as claimed in claim 1, wherein said server obtains said registration information from said user by generating prompts according to a decision tree.

15. (Original) A method as claimed in claim 14, wherein server logic for generating said prompts resides in controller classes which co-ordinate logic flow.

16. (Original) A method as claimed in claim 1, wherein said server prompts said user to enter said registration information into one or more displays which are dynamically generated based on previously entered information.

17. (Original) A method as claimed in claim 16, wherein said step of obtaining registration information comprises using registration page modules for receiving and validating at least a portion of said registration information.

18. (Original) A method as claimed in claim 17, wherein said step of obtaining registration information comprises linking said user to remote applications.

19. (Previously Presented) A system for providing electronic commerce electronic data interchange (EDI) products and services for EDI between a user and one or more trading partners, the system comprising:

a database for storing requirements information relating to predetermined electronic commerce EDI requirements of a plurality of trading partners;

an application for obtaining first information from said user to identify a plurality of selected trading partners for exchanging EDI information related to trading with the selected trading partners, retrieving requirements information from said database based at least in part on said first information, and automatically displaying suitable electronic commerce EDI products or services to said user based at least in part on said requirements information; and
a registration module for obtaining registration information from said user to register said user for one or more of said suitable EDI products or services.

20. (Previously Presented) A system as claimed in claim 19, wherein said database stores electronic commerce EDI requirements information for a plurality of hub trading partners.

21. (Original) A system as claimed in claim 19, wherein said registration module obtains said registration information by prompting said user to enter information into one or more preformatted displays.

22. (Original) A system as claimed in claim 21, wherein said registration module divides said registration information into common registration information and other registration information, and stores said common registration information so that it is readily accessible in a block.

23. (Original) A system as claimed in claim 22, wherein said registration module prepopulates one or more of said preformatted displays with common registration information previously entered by said user.

24. (Original) A system as claimed in claim 19, wherein said registration module prompts said user for configuration information to configure one or more of said products or services.

25. (Original) A system as claimed in claim 19, wherein said registration module includes a facility for generating and sending a message to a sales channel to follow up in providing electronic commerce products or services desired by said user.

26. (Original) A system as claimed in claim 19, wherein said registration module prompts said user to enter said registration information into one or more displays which are dynamically generated based on previously entered information.

27. (Previously Presented) A system for providing electronic commerce electronic data interchange (EDI) products and services for EDI between a user and one or more trading partners, the system comprising:

means for obtaining first information from said user to identify a plurality of selected trading partners for exchanging EDI information related to trading with the selected trading partners;

means for retrieving requirements information relating to predetermined electronic commerce EDI requirements of said selected trading partners;

means for automatically determining suitable electronic commerce EDI products or services for said user based at least in part on said requirements information; and

means for obtaining registration information from said user to register said user for one or more of said suitable EDI products or services.

28. (Previously Presented) A computer program product stored on a computer readable medium having program code, that causes, when executed, a computing system to provide electronic data interchange (EDI) products and services for EDI between a user and one or more trading partners, the program code comprising:

code for obtaining first information from a said user to identify a plurality of selected trading partners for exchanging EDI information related to trading with the selected trading partners;

code for retrieving requirements information relating to predetermined electronic commerce EDI requirements of said selected trading partners;

code for automatically determining suitable electronic commerce EDI products or services for said user based at least in part on said requirements information; and

code for obtaining registration information from said user to register said user for one or more of said suitable EDI products or services.